

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1, 4-11, 17, 20-22, 30-36, 39, 42-50 and 52-54 are pending, with claims 1, 4-6, 8, 14, 17, 20-21, 30, 34, 39, 42-44, 46, 50 and 52-53 amended, and claims 3, 12-13, 15-16, 19, 25-26, 28-29, 37-38, 41 and 51 cancelled without prejudice or disclaimer, by the present amendment. Claims 1, 8, 17, 30, 34, 39, 46 and 50 are independent.

In the Official Action, claims 1, 12-13, 15-17, 19-22, 25-26, 28-37, 39, 42-45 and 50-54 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lamkin (U.S. Patent Pub. No. 2005/0251749, now U.S. Patent No. 7,545,515). Claims 3-11, 38, 41 and 46-49 were indicated as containing allowable subject matter.

Applicant acknowledges with appreciation the indication of allowable subject matter.

As a first point of order, Applicant submits that Lamkin is an improper reference upon which to base a rejection. A comparison of Applicant's originally filed claims and Lamkin's claims reveal that Lamkin copied Applicant's claims *verbatim*. Furthermore, many of the rejections based on Lamkin only cite to Lamkin's claims. Applicant directs the Examiner to In re Benno, 226 USPQ 683, 786 F.2d 1340, which notes, *inter alia*:

The scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses. A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding....Danti's claim 1 does not disclose any structure additional to what the Danti specification discloses. For the above reasons, we hold that the board erred in relying on Danti's claim 1 in deciding that appellant's claims would have been obvious from that reference alone and also in reaching that conclusion.

In other words, it is improper to base a rejection solely on the contents of a reference's claims. The rejection must be based on the disclosure of the specification, not merely the claims. In rejecting

Applicant's claims, the Official Action repeatedly cites to just Lamkin's claims for a variety of features. In view of *In re Benno*, if the Lamkin reference is again applied as a basis of rejection, Applicant requests specific citations to Lamkin's specification, not claims, for each and every feature recited in Applicant's claims.

However, to expedite progress toward allowance, the present amendment:

- o incorporates the allowable features of dependent claim 3 into independent claim 1; therefore, independent claim 1 is in condition for allowance.
- o incorporates the allowable features of dependent claim 19 into independent claim 17; therefore, independent claim 17 is in condition for allowance.
- o incorporates the allowable features of dependent claim 38, and intervening claim 37, into independent claim 34; therefore, independent claim 34 is in condition for allowance.
- o incorporates the allowable features of dependent claim 41 into independent claim 39; therefore, independent claim 39 is in condition for allowance.
- o incorporates the allowable features of dependent claim 51 into independent claim 50; therefore, independent claim 50 is in condition for allowance.
- o amends allowable dependent claims 8 and 46 into independent form; therefore, independent claims 8 and 46 are in condition for allowance.
- o amends dependent claims 4-6, 14, 20-21, 42-44 and 52-53 to maintain antecedent support.

Turning now to independent claim 30, claim 30 has amended to recite, *inter alia*, "along with capacity information associated with a buffer memory of said device" and "c) when contents information from the contents provider server is received at an adjusted bit rate, resume synchronously reproducing data read from the recording medium and the received contents information." Applicant submits that amended independent claim 30 is in condition for

allowance for reasons similar to those acknowledged in the Official Action relative to allowable claims 3-11, 38, 41 and 46-49, and in view of *In re Benno*, 226 USPQ 683, 786 F.2d 1340, discussed above.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael E. Monaco, Reg. No. 52,041 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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